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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,584

04/09/2004

Terrance P. Snutch

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08/05/2010

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

EXAMINER

BLAKELY III, NELSON CLARENCE

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

08/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,584

Applicant(s)

SNUTCH ET AL.

Examiner

NELSON C. BLAKELY III

Art Unit

1614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7-9 and 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 05/20/2009, 08/05/2009 and 10/09/2009.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

Application Status

Claims 1-17 of the instant application are pending. Claims 3-5, 7-9 and 11-17 are withdrawn pursuant to Applicant's Amendment, filed 08/14/2009. Accordingly, instant claims 1, 2, 6 and 10 are presented for examination on their merits.

Applicant's Arguments, filed 08/14/2009, have been fully considered. Rejections/objections not reiterated from previous Office Actions are hereby **withdrawn**. The following rejections/objections are either reiterated or newly applied. They constitute the complete set of rejections/objections presently being applied to the instant application.

As per MPEP § 803.02, the Examiner will determine whether the entire scope of the claims is patentable. The elected subject matter, i.e., a method to therapeutically treat pain, which method comprises administering to a subject in need of such treatment an amount of a compound of formula (1), wherein n^1 is 1, R^1 is CF_3 and n^2-n^5 are all 0 (See P1 in Figure 1), appears to be free of the art. Since the elected species appear to be free of the art, but the entire scope of the claims was not found to be allowable, claims to all other non-elected subject matter are held withdrawn from further consideration.

Information Disclosure Statement

The Information Disclosure Statements, filed 05/20/2009, 08/05/2009 and 10/09/2009, are acknowledged and considered. Omitted information, e.g., author names, has been supplied by the Examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically in instant claims 1 and 2, the recitation "alkyl (1-10C), alkenyl (2-10C), alkynyl (2-10C), aryl (6-10C), alkylaryl (7-16C) or alkenylaryl (7-16C)" renders the claims indefinite. The rejection is based on parenthetical subject matter. Confusingly, it is unclear to the Examiner, or one of ordinary skill in the art, at the time of the invention, whether or not a claim limitation is intended by the parenthetical subject matter. A suggestion to obviate the rejection is to amend the claims to recite the number of carbon atoms prior to the substituent definition, e.g., C_{1-10C} alkyl, C_{2-10C} alkenyl, etc.

Instant claim 1 recites "(N, O or S)" which renders the claim indefinite. See lines 9 and 14 of the claim. The rejection is based on parenthetical subject matter. Confusingly, it is unclear to the Examiner, or one of ordinary skill in the art, at the time of the invention, whether or not a claim limitation is intended by the parenthetical subject matter. A suggestion to obviate the rejection is to amend the claims to recite that the heteroatoms are selected from the group consisting of N, O and S, e.g., further containing 1-4 heteroatoms selected from the group consisting of N, O and S.

In instant claim 1, the recitation "said optional substituents may include =O" renders the claim indefinite. Confusingly, it is unclear to the Examiner, or one of

ordinary skill in the art, at the time of the invention, what substituents, if any, are excluded from this definition. Clarification is required.

In instant claim 1, the recitation " R^3 may be keto if $n^3 = 1$ " renders the claim indefinite. Confusingly, it is unclear to the Examiner, or one of ordinary skill in the art, at the time of the invention, whether or not R^3 is limited to keto if n^3 is 1, or what other substituents, if any, may R^3 be if n^3 is 1. Clarification is required.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NELSON C. BLAKELY III whose telephone number is (571) 270-3290. The examiner can normally be reached on Mon - Thurs, 7:00 am - 5:30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Phyllis G. Spivack/
Primary Examiner, Art Unit 1614
August 2, 2010

/N. C. B. III/
Examiner, Art Unit 1614